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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,104	02/17/2004	Gerd Frankowsky	INF 2127-US	6502

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MOSER, PATTERSON & SHERIDAN, LLP
GERO G. MCCLELLAN/INFINEON
3040 POST OAK BLVD.,
SUITE 1500
HOUSTON, TX 77056

EXAMINER	
KARLSEN, ERNEST F	

ART UNIT	PAPER NUMBER
2829	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/780,104	FRANKOWSKY ET AL.	
	Examiner	Art Unit	
	Ernest F. Karlsen	2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *1-6 and 14-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0204*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election with traverse of Group I and the species of Figure 2 in the reply filed on 18 March 2005 is acknowledged. The traversal is on the ground(s) that the inventions must be independent with different classification and present a burden of examined together. This is not found persuasive because Applicants have not shown that the groups are not patentably distinct. Admission on the record by Applicants that the groups are not patentably distinct will result in rejoinder. Applicants appear to be arguing that same subclass of classification means same invention. If such were carried to its logical conclusion there could only be one patent per subclass and Applicants could be denied a patent on the basis that there is already at least one patent in class 324, subclass 765. With regard to the "no burden" argument, it is noted that each distinct invention beyond one is a burden in that it draws the attention of the Examiner to its own requirements. Examination requires focus to follow search leads and patterns of logic in formulating applications of the prior art to that which is claimed. When the Examiner has to pursue several search patterns of logic simultaneously or serially, added burden is presented. In order to examine several inventions and/or species simultaneously or serially, added effort beyond that necessary for one invention or species must be expended.

Where the effort is serial and the jobs are different the added burden is obvious. Digging two equal holes of the same size requires twice the effort of digging one hole. Such is an obvious conclusion. It can be argued that some inventions or species can be examined simultaneously but such is true only if they are not patentably distinct, that is, if that which applies to any one applies to all others. Where inventions or species are patentably distinct each requires separate consideration. As a for instance, consider a properly restrictable apparatus and method of use of that apparatus where one has details without correspondence in the other. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other constitutes a burden. If the apparatus and method of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. As a second for instance, consider a properly restrictable combination and subcombination where all the details of the subcombination are not necessary for the combination. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other is a burden. If the combination and subcombination of the above example are not patentably distinct no burden is presented in

examining both since if one falls the other falls as well. Admission on the record that the groups are not patentably distinct will result in rejoinder. It is further noted that Section 803 of the M.P.E.P. requires that the inventions be independent or distinct not just independent. The same requirement also appears in Sections 808 and 816 of the M.P.E.P. The argument that claim 14 of Group II is generic is not relevant since Group II is not elected. In addition note the last three paragraphs of page 3 of the restriction/election requirement where it states that inclusion of a generic claim does not obviate restriction/election.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-6 and 14-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and/or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 18 March 2005.

Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in

independent form. Claim 9 is drawn to a feature that appears only in Figure 1 and no disclosure for using such a feature in Figure 2 is present.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson et al. With regard to claim 7, Anderson et al show an integrated test circuit in an integrated circuit for testing a plurality of internal voltages. A switching device 21 selects input responses of internal elements in accord with selection signal outputs from element 22. Shift registers 25 are storage elements in communication with a comparator device 26. (See columns 2-4 of Anderson et al.) The comparator device 26 compares the outputs of the shift registers 25 to an expected result which are a series of externally provided reference voltages. (See column 4 of Anderson et al.) Note that data signals, normally a series of ones and

zeros are internal voltages. With regard to claim 8, anything that switches a first terminal between plural second terminals is considered a multiplexer and gates 21 serve such a purpose. With regard to claim 9, outputs of logic circuits inherently are voltage dividers and in the case of logic circuits the output of each that is supposed to be, say a logic 1, is at the same potential for each voltage divider, i.e., logic output. With regard to claim 10, terminal 27 of Anderson et al, is connected to the storage element 25 (shift registers) via the switching elements of the shift registers. (See Figure 7 and associated text.) With regard to claims 11-13, the signal terminal is considered any input of the shift register 25 and the shift registers are storage devices and a switching element to apply a reference voltage to the comparator 26. (See Figure 1.) The shift register 25 is in communication with input and output lines of the integrated circuit via additional circuitry. Control circuit 29 controls the switching apparatus of Anderson et al.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Brunt, Stoica, Tanksalvala et al and Oke et al are cited to show additional on chip test apparatus for integrated circuits.

The status indicators of the non-elected claims in the response of 18 March 2005 are in error.

No copy of Item C1 of the Substitute for form 1449A/PTO submitted by Applicants is present in the file, therefore Item C1 has been crossed out and not considered.

Any inquiry concerning this communication should be directed to Ernest F. Karlsen at telephone number 571-272-1961.

Ernest F. Karlsen

May 28, 2005

Ernest F. Karlsen

ERNEST KARLSEN
PRIMARY EXAMINER